

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application Number : 09/599,602 Confirmation No.: 1459
Applicant : Robert J. Rosko
Filed : June 23, 2000
Title : System and Method for Implementing a Consolidated Application
Process
TC/Art Unit : 3624
Examiner: : James M. Alpert

Docket No. : 47004.000073
Customer No. : **21967**

MAIL STOP Appeal Brief - Patent
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

**RESPONSE TO NOTIFICATION
OF NON-COMPLIANT APPEAL BRIEF**

Sir:

This paper is responsive to the Notification of Non-Compliant Appeal Brief mailed November 2, 2006. The Notification finds the Appeal Brief filed on August 29, 2005, defective for failure to comply with one or more provisions of 37 C.F.R. 41.37. A substitute brief is filed herewith.

The Notification notes that the claims appendix should be labeled with a heading "Claims Appendix." Appellant's file copy of the August, 2005, brief includes a page bearing the heading "Claims Appendix" on a separate page prior to the listing of the claims. The Substitute Appeal Brief filed herewith includes the required heading.

In the Office Action mailed February 10, 2005, the Examiner purported to reopen prosecution of the instant application. The Examiner asserted new grounds of rejection under 35 U.S.C. § 103(a) as being unpatentable over Lebda *et al.* (U.S. Patent 6,385,594) in view of Bennett *et al.* (U.S. Patent Application Publication #20010047307). Appellant appealed this new rejection. Appellant responded to the new grounds of rejection in the Appeal Brief. Appellant argued, *inter alia*, that the Examiner fails to establish that the secondary reference (Bennett) is available as prior art against appellant's claims. The instant application was filed June 23, 2000.

Bennett is a U.S. Patent Application Publication of an application filed November 29, 2001. The Bennett application on its face states that it makes reference to, and claims priority to and the benefit of, U.S. provisional application Ser. No. 60/190,825 filed March 21, 2000. Appellant argued that this provisional application does not support the subject matter relied upon to make the Examiner's rejection. As a courtesy, appellant included the relevant provisional application in the Evidence Appendix of the Appeal Brief.


The Notification states that the Examiner is not sure whether the provisional application document was submitted anywhere in the prosecution history as evidence. Appellant note that the Examiner must rely on the provisional Application Ser. No. 60/190,825 to establish that the applied secondary reference is available as prior art. An Evidence Appendix may properly include evidence relied upon by the Examiner as to the grounds of rejection to be reviewed on appeal. 37 C.F.R. § 41.37(ix). Appellant reiterates the argument that Bennett does not qualify as prior art in the Substitute Appeal Brief Submitted herewith. However, in compliance with Notification, the relevant provisional application is removed from the Evidence Appendix.

Appellant submits that the Substitute Appeal Brief submitted herewith complies with the requirements of 37 U.S.C. § 41.37. Appellant respectfully requests that the appeal brief be considered. Applicant is unaware of any fees due with this submission. However, should the Office determine that fees are due with this paper or the with accompanying brief, please charge any such fees to the undersigned's Deposit Account No. 50-0206.

Respectfully submitted,
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Dated: November 21, 2006
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